

REMARKS

Claims 1-5 and 7 are pending in the application. By this Amendment, claims 1, 2 and 7 have been amended. It is submitted that this Amendment is fully responsive to the Office Action dated February 18, 2009.

Objections to the Drawings

On page 2, item 1 of the Action, the drawings are objected to because the drawing in a nonprovisional application must show every feature of the invention specified in the claims under 37 C.F.R. 1.83.

This objection is respectfully traversed. Specifically, the Examiner alleges that the drawings fail to show that the cover member does not approach within the predetermined range (0.2mm) around the writing tip as shown by the dash double-dotted lines, specifically in Fig. 4, as described in the specification.

It appears that this objection is caused by vagueness of claims 1 and 2 as discussed below with the rejection under 35 U.S.C. §112. Accordingly, it is believed that this objection is also avoided by clarifying claims 1 and 2 as discussed below.

Objections to the Specification

On page 3, item 2 of the Action, claims 1, 2 and 5 are objected to as including informalities.

This objection is respectfully traversed. It is submitted that those clerical errors have been corrected by the present Amendment.

On page 3, item 3 of the Action, paragraph [0015] is objected to as including an unclear description.

This objection is respectfully traversed. It is submitted that the paragraph [0015] has been amended in accordance with amended claims 1 and 2. Moreover, it appears that this objection addresses issue similar to the rejection under 35 U.S.C. §112. Accordingly, it is believed that this objection is also avoided by Applicant's arguments with regard to the rejection under 35 U.S.C. §112 as discussed below.

Next, the Examiner alleges, "several times the specification recites that "a part" or "the part" of the cover member does not approach within 0.2mm of the writing tip. It is confusing what 'part' of the cover member the applicant is referring to." It is believed that, by the Preliminary Amendment filed on August 18, 2006, Applicant already deleted the subject words such as "a part of" or "the part of" from the specification. The Examiner's reconsideration is respectfully requested.

Claim Rejections – 35 U.S.C. §112

Claims 1-5 and 7 are rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement.

This rejection is respectfully traversed.

With regard to the claimed recitation of “*said cover member is arranged in dimensions so as not to approach within 0.2 mm of said writing tip when said cover member is fitted...*,” the Examiner alleges that it is confusing whether the cover member is arranged in dimensions so as not to approach within 0.2 mm of the writing tip (1) only during the process when the cover member is being fitted, or whether that limitation applies (2) after the cover member is fully fitted on the joint member, or (3) during both scenarios.

It is submitted that the feature of “when said cover member is fitted along the perimeter surface of the joint member to which the writing tip is mounted” in claim 1 is an exact moment at which the cover member contacts with the joint member as shown in Figs. 2, 4, 6, 8, and 12. As described in paragraph [0029], because when the cover member is somewhat pushed along the perimeter surface of the joint member, the perimeter surface of the joint member serves as a guide, if the cover member does not approach within 0.2 mm around the above-mentioned writing tip at the moment which the cover member contacts with the joint member, then the cover member cannot contact with writing tip because of the guide. Moreover, claim 2 is shown in Fig 10, but not in Fig. 11.

To clarify this point, claim 1 has been amended to include “when an end of said cover member is positioned so as to be in contact with the perimeter surface of said joint member and an axis of said cover member and an axis of said joint member are aligned” as supported by the specification (paragraph 0027, lines 10-13).

Also, claim 2 has been amended to include “when an end of said cover member is positioned so as to be in contact with an inner periphery of the mounting hole and an axis of said cover member and an axis of said joint member are aligned” as supported by the specification (paragraph 0053, lines 1-5).

In view of the above, withdrawal of this rejection is respectfully requested.

Claims 1-5 and 7 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

This rejection is respectfully traversed. It is submitted that claims 1 and 2 have been amended to overcome this rejection.

Claim Rejections - 35 U.S.C. §103

Claims 1-5 and 7 are rejected under 35 U.S.C. §103(a) as being unpatentable over Sekine (USP 6,076,987).

Claim 1 calls for the feature of “*said cover member is arranged in dimensions so as not to approach within 0.2 mm of said writing tip.*” Also, independent claim 2 includes similar feature.

With regard to the disclosure of Sekine, the Examiner clearly acknowledges the drawbacks and deficiencies of Sekine, that is, Sekine does not disclose “*said cover member is arranged in dimensions so as not to approach within 0.2 mm of said writing tip.*”

In an attempt to cure the above-noted drawbacks and deficiencies of Sekine, the Examiner relies on *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1742, 82 USPQ2d 1385, 1396 (2007) and alleges that simply modifying the gap between the cover member and writing tip would involve only routine skill in the art; in other words, the discovering of an optimum distance between the writing tip and cover member is not of innovation but of ordinary skill and common sense. (pages 5-7 of the Action).

KSR is a valid U.S. Supreme Court case regarding obviousness. *KSR* primarily discussed the obviousness of the combination of old elements such as a combination of a mechanical pedal and a pedal position sensor. However, *KSR* did not directly discuss anything about optimization.

As to Optimization of Ranges

“[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation.” *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955). However, there is an EXCEPTION to rule that discovery of optimum value of variable in known process is normally obvious occurs when parameter optimized was not recognized to be result effective value.

In other words, a particular parameter must first be recognized as a result-effective variable, i.e., a variable which achieves a recognized result, before the determination of the optimum or workable ranges of said variable might be characterized as routine experimentation.

In re Antonie, 559 F.2d 618, 195 USPQ 6 (CCPA 1977). Also, MPEP 2144.05

Sekine relates to a pipe type ballpoint pen adapted for writing thin characters. Sekine discusses the problem with a conventional ballpoint pen as:

If the outer diameter of the front pipe portion and that of the ball at the front end are reduced in order to obtain a ballpoint pen suitable for producing thin handwritten characters, chances of the front pipe portion being bent with even a slight writing pressure increase.

The object of Sekine is to provide a ballpoint pen optimal for writing thin characters which does not cause the ballpoint pen tip to be bent by the writing pressure at the time of writing nor gives a user a sense of unstable writing due to the ballpoint pen tip shaking at the time of writing, and which does not allow the ballpoint pen tip to be collapsed into the holder.

To achieve this objective, the first embodiment of Sekine discloses “the outer diameter D of the pipe 21 used for the ballpoint pen tip 2 of the present invention is set to 0.5 mm and the thickness T thereof, to 0.09 mm. The length L of the pipe portion 3 projecting outward from the front end of the support tube 5 is set to 1.0 mm.

The length L, the outer diameter D, and the thickness T of the pipe portion 3 satisfy a first relational expression ($L/D \leq 4.0$) and a second relational expression ($L/TD^2 \leq 80$) simultaneously to prevent bending at the joint of the pipe portion 3 at the time of writing with the ballpoint pen" (column 6, lines 4-13 and Figs. 1-3). Other embodiments also satisfy the above-mentioned relational expressions (column 7, lines 52-55 and column 8, lines 61-66).

Accordingly, in Sekine, the distance between the cover member and the writing tip was not recognized as a result-effective variable in order to avoid the problem that the cover member damages the writing tip and thus, the Examiner's allegation of the optimization should be vacated in view of the exception established by *In re Antonie*.

As to Teach Away

Moreover, Sekine repeatedly describes that a gap 54 as depicted, for example, in Fig. 2 ranges from 0.001 to 0.1mm in order to prevent unstable writing (column 5, lines 52-59 and column 7, lines 10-15). In other words, Sekine discloses that the support tube 5 must approach the ballpoint pen tip 2 closer than 0.1mm. Therefore, Sekine **teaches away** from the claimed feature of "*said cover member is arranged in dimensions so as not to approach within 0.2 mm of said writing tip*," as called for in claim 1 and similarly in claim 2.

Therefore, claims 1 and 2 distinguish over Sekine.

Claims 3-5 and 7 are dependent from claim 1 or 2 and recite the additional features set forth therein. Accordingly claims 3-5 and 7 also distinguish over Sekine for at least the reasons set forth above.

As to claim 7

Moreover, claim 7, as amended to correct clerical error, now calls for the feature of "*a flange bent outward is formed at one end of said cylindrical portion, so that said flange may come into contact with an end face of the joint member.*"

With regard to this feature, the Examiner relies on Fig. 4 of Sekine. Specifically, in the annotated figures included on page 8 of the Action, the Examiner alleges that a portion of a support tube 5 which is located in the right most portion thereof corresponds to the flange.

However, as shown in Fig. 4, the right most portion of the support tube 5 is in the form of straight tube with a setback portion on its inner surface. In other words, Sekine merely discloses a straight tube in which the thickness of the tube varies.

On the contrary, in the present claim, a flange which is bent outward is formed at one end of said cylindrical portion.

Accordingly, Sekine fails to disclose or fairly suggest the claimed feature of "*a flange bent outward is formed at one end of said cylindrical portion, so that said flange may come into contact with an end face of the joint member,*" as called for in amended claim 7.

In view of the aforementioned amendments and accompanying remarks, Applicants submit that the claims, as herein amended, are in condition for allowance. Applicants request such action at an early date.

If the Examiner believes that this application is not now in condition for allowance, the Examiner is requested to contact Applicants' undersigned attorney to arrange for an interview to expedite the disposition of this case.

If this paper is not timely filed, Applicants respectfully petition for an appropriate extension of time. The fees for such an extension or any other fees that may be due with respect to this paper may be charged to Deposit Account No. 50-2866.

Respectfully submitted,
WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP



Tsuyoshi Nakamura
Limited Recognition No. L0396
Telephone: (202) 822-1100
Facsimile: (202) 822-1111

TN/ya
Encl.: Limited Recognition



**BEFORE THE OFFICE OF ENROLLMENT AND DISCIPLINE
UNITED STATES PATENT AND TRADEMARK OFFICE**

LIMITED RECOGNITION UNDER 37 CFR § 11.9(b)

Tsuyoshi Nakamura is hereby given limited recognition under 37 CFR § 11.9(b) as an employee of the Westerman Hattori Daniels & Adrian, LLP law firm to prepare and prosecute patent applications wherein the patent applicant is the client of the Westerman Hattori Daniels & Adrian, LLP law firm, and an attorney or agent of record in the applications is a registered practitioner who is a member of the Westerman Hattori Daniels & Adrian, LLP law firm. This limited recognition shall expire on the date appearing below, or when whichever of the following events first occurs prior to the date appearing below: (i) Tsuyoshi Nakamura ceases to lawfully reside in the United States, (ii) Tsuyoshi Nakamura's employment with the Westerman Hattori Daniels & Adrian, LLP law firm ceases or is terminated, or (iii) Tsuyoshi Nakamura ceases to remain or reside in the United States on a H1B visa.

This document constitutes proof of such recognition. The original of this document is on file in the Office of Enrollment and Discipline of the United States Patent and Trademark Office.

Limited Recognition No. L0396
Expires: September 30, 2009



Harry J. Moatz
Director of Enrollment and Discipline